



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,402	07/05/2000	Jonathan Stephen Levkoff	MSGNT-001	4157

26137 7590 08/12/2003

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10036

EXAMINER

LE, HIEU C

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 08/12/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,402

Applicant(s)

LEVKOFF ET AL.

Examiner

Hieu c. Le

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2142

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10¹⁷⁻²¹ drawn to a method for communicating messages to users, the users employ communication devices on service networks, the service networks playing various protocols, classified in class 709, subclass 230.
 - II. Claims 11-¹⁶22, 29,32 drawn to a method for transmitting a message to a recipient, the recipient is associate with an alias identifier, the alias identifier is associated with at least on permission criteria, the alias identifier is further associated with at least one communication device, classified in class 709, subclass 206.
 - III. Claims 23-27, drawn to a method for creating a user group, the user group facilitates the transmission of messages to members of the group, classified in class 709, subclass 204.
 - IV. Claim 28, drawn to a method for facilitating the transmission of a message by a service provider network to a user on a foreign network, the foreign network can not be directly reached by the service provider network, classified in class 709, subclass 245.
 - V. Claims 30-31, drawn to a method for facilitating the reception of a messages by users of a first message system, the messaging system employing alias identifiers in place of device address, the message originating from a second message system, classified in class 709, subclass 246.

Art Unit: 2142

2. The inventions are distinct, each from the other because of the following reasons:

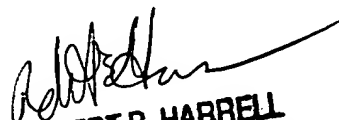
Inventions I, II, III, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a unique identifier to a user and associating at least one messaging permission with the identifier, and communicating a message to a user by transmitting the message to the communicating devices associated with the recipient identifier of the message, the message transmitted in accordance with device protocol, device address ; Invention II has separate utility such as selecting a user alias, verifying that the selected alias is for a register recipient, compiling a message for the recipient, invention III has separate utility such as assigning a group owner to the group, assigning members to the group by employing identifiers of registered members, Invention IV has separate utility such as storing a device address list, employing a third party service to transmit the message to a user on the foreign network, Invention V has separate utility such as a first database remote from the first and second data transmission system, also including user profile data, second database local to the first data transmission system, a third database local from the second data transmission system. See MPEP. § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the search required for Group I, II, III, IV is not required for Group V, restriction for examination purposes as indicated is proper.

Art Unit: 2142

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Guy Perry on 8/2/03 to request an oral election to the above restriction requirement, but did not result in an election being made.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:00 PM.

The fax number of this Group 2757 is (703) 308-5397 or 305-7201. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


ROBERT B. HARRELL
PRIMARY EXAMINER